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November 13, 2006

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 3654
Patent Examiner Rakesh Kumar

Re:

Application No.:	**10/796,448**
Confirmation No.:	**2402**
Applicants:	**Graef, et al.**
Title:	**Cash Dispensing Automated Banking Machine and Method**
Docket No.:	**D-1217 R2**

Sir:

Please find enclosed a Notice of Appeal for filing in the above-referenced application. Also enclosed is a Pre-Appeal Brief Request for Review.

Please charge the fee ($500) associated with submission of the Notice of Appeal, and any other fee due, to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Graef, et al.**	)	
Application No.: **10/796,448**	)	Art Unit 3654
Confirmation No.: **2402**	)	
Filed: **March 9, 2004**	)	Patent Examiner Rakesh Kumar
Title: **Cash Dispensing Automated Banking Machine and Method**	)	

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request review of the rejections in the above-identified application (as presented in the Office Action dated August 28, 2006).

No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

The review is requested for the reason that the rejections are not legally valid because the applied references do not render the claims obvious.

Claim Status

Claims 2-39 are pending. Claims 2, 3, 35, 36, 38, and 39 are independent.

Claims 2-11, 15-17, 23-24, and 35-39 were rejected under 35 U.S.C. § 103(a) over Furuki (US 6,000,689) in view of Geib (US 5,207,788) and further in view of Graef (US D444,803).

Claims 12-14, 18-22, and 25-34 were indicated allowable if rewritten as independent.

Argument

Appellants respectfully disagree with the features attributed to the references. The Office has not established a *prima facie* case of obviousness. Nor would their combination have been obvious to one having ordinary skill in the art, as alleged by the Office. Furthermore, even if it were somehow possible (for sake of argument) to have combined the references as alleged, the result still would not have produced in the recited apparatus.

The Graef reference

The Office attributes subject matter to Graef that Graef does not teach or suggest. The Office then relies on this misconstrued understanding of Graef for each claim rejection. Thus, the rejections are improperly based.

The Office alleges that Graef teaches:

> "a central tread at the outer surface of the wheel is essences to create greater frictional contact at the center area of the segment. Grafe furthermore disclose an area which is adjacent and transversely disposed from the high friction central arcuate tread segment. Grafe discloses a tread structure which is indented into the outer surface of the feed wheel to create a section of high friction surrounded by smooth area at the peripheral edges" (Action page 4, lines 7-12).

"a rotatable picking member with a centrally adjacent and transversely disposed high friction arcuate segment surrounded by a smooth area at the peripheral edges" (Action page 5, lines 3-5).

"a 'Feed wheel tread' along with a detailed drawing depicting a region of the feed wheel wherein the stated 'tread' is localized in the center vicinity of the feed wheel with no tread configuration around the encompassing border of the 'tread' region" (Action page 11, lines 11-13).

With regard to Graef, the Office alleges that:

"It would have been obvious to one of ordinary skill in the art at the time of the invention was made to view the structure of Graef in light of the disclosed prior art (above) and glean that a tread like configuration can be disposed at a center of a feed wheel which can be encircled by a non-treaded region. A treaded region as compared to a non-treaded region in the view of the Office will inherently provide higher friction in the threaded region and lower friction in the non-treaded region" (Action page 11, lines 14-19).

The facts of record

Graef is a design patent. It is to an ornamental design and has no disclosed functional benefits. The Office has not explained how a non functional ornamental design can be used to render a functional apparatus obvious. Furthermore, except for the feed wheel tread design shown, all features attributed to Graef by the Office are pure speculation.

For example, where does Graef specifically teach "greater frictional contact at the center area of the segment" and a "transversely disposed high friction arcuate segment surrounded by a smooth area at the peripheral edges" as alleged by the Office? Where does the design patent teach or suggest any material properties of the ornamental design? It doesn't. Nor can any area be identified as a high friction area or a low friction area.

Appellants request that the Office send them a copy of a marked up version of the Graef reference showing exactly where the high and low friction areas in the Graef figures are located. Appellants further request that the Office specifically point out the page and line numbers in the Graef reference that teaches these alleged areas as being high and low friction areas.

Appellants respectfully disagree with the Office's view that a "treaded region as compared to a non-treaded region . . . will inherently provide higher friction in the threaded region and lower friction in the non-treaded region". If the Office's view was accurate (which it isn't), then why don't dragsters use treaded tires? Also, how does a tread in an all plastic roller provide any greater friction? The Office's reasoning, on which all the rejections are based, is without merit.

It follows that the rejections are improperly based on speculation. However, evidence of record must teach or suggest the recited features. Assertions not based on evidence in the record lack substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). A determination of patentability must be based on evidence in the record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The Office has failed to document its evidence for rejection on the record, which is a mandatory requirement to allow appellate review of the basis for denial of a patent. Appellants are not required to prove patentability. Rather, the burden is on the Office to establish a case of obviousness under the law. Otherwise, the Office is legally required to grant a patent.

Appellants reserve all rights to present additional arguments

For the reason of total pages allowable herein, the Appellants has not necessarily presented all their reasons herein as to why the applied references do not render the claims obvious. Appellants reserve the right to later present additional reasons. Nevertheless, Appellants' arguments show that the applied references, whether taken alone or in combination, do not teach or suggest all of the features and relationships of the claimed invention. The applied references are devoid of any teaching, suggestion, or motivation to produce the recited apparatus. Appellants' claims patentably distinguish over the applied references. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

Conclusion

Appellants respectfully submit that all the pending claims are allowable.

Respectfully submitted,

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